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Application Number

10/671,078

Filing Date

9/25/2003

First Named Inventor

Robert Parlee

Art Unit

3611

Examiner Name

Lerner, Avraham H

Attorney Docket Number

parlee01.005

ENCLOSURES (Check all that apply)

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Gordon E. Nelson, Patent Attorney PC		
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parlee01.005

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(parlee01.005)

Applicant: Robert Parlee **Paper No.:**
Application No: 10/671,078 **Group Art Unit:** 3611
Filed: 9/25/03 **Examiner:** Lerner, Avraham H.

Title: *Techniques for making carbon fiber bicycle frames*

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Commissioner for Patents
Alexandria, VA 22313-1450

Response to a restriction requirement under 35 U.S.C. 121

Summary of the prosecution

In an Office action mailed 9/17/2004, Examiner found three inventions in the application:

- group I, consisting of claims 1-6 and 11-16,
- group II, consisting of claims 7-10, and
- group III, consisting of claims 17-23.

Examiner further required with regard to group II and III that restriction further be made to Species A, set forth in claims 8 and 18 or Species B, set forth in claims 9 and 19.

Response

Election of claims

Applicants are electing group III with traverse and within group III are electing Species B without traverse pending a finding that generic claim 18 is allowable.

Traversal of the restriction requirement as regards group II and group III

The basis of Examiner's requirement of a restriction between group II and group III is the following:

In the instant case the product as claimed can be made by another and materially different process, for example, one not including curing the lug

in a mold, specifically because a product-by-process claim as in claim 7 is not limited to the manipulations of the recited steps, only the structure implied by those steps. (Restriction Requirement, p. 2, bottom)

The claims of group II are addressed to a bicycle frame comprising a plurality of carbon fiber tubes joined at joints and lugs at the joints that are made by a particular method. The issue, as set forth at MPEP 806.05(f) is whether “the product *as claimed* can be made by another and materially different process”. The language that Examiner uses in dealing with the issue, “a product-by-process claim as in claim 7 is not limited to the manipulations of the recited steps, only the structure implied by those steps” comes from MPEP 2113, which deals with patentability of product-by-process claims. As the first example in MPEP 2113 makes clear, when the product made by the process is indistinguishable from the same product made by another process, the process steps should not be considered when assessing the patentability of the claimed product over the product made by the other process. As the second example makes clear, where “the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product”, the process steps should be considered when assessing the patentability of the product-by-process claims over the prior art.

In the instant case, the second example applies. As is clear from the discussion of prior-art techniques for making lugs at page 2, lines 8-13 of the above patent application and the discussion of the lug-making techniques used with Applicant’s carbon-fiber frames, lugs made according to Applicant’s methods do “impart distinctive structural characteristics to the final product”. Among the characteristics are the following:

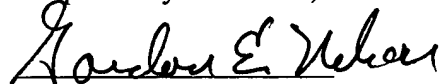
1. Applicant’s lugs do not contain the voids that occurred using prior-art techniques (p.6, lines 12-14);
2. Applicant’s lugs are tapered down to the tube, which improves the lug’s appearance and improves the distribution of stress along the tubes jointed by the lugs (p. 6, lines 26-30); and
3. when the expandable foam is used, the lug has a smoother surface (p. 7, lines1-5).

The characteristic that Applicant's lugs do not contain voids is of course a necessary result of the fact that, as set forth in independent claim 7, "the cure include[es] an expansion of an element enclosed by the mold". Consequently, "the product *as claimed*" cannot "be made by another and materially different process", the method steps must therefore taken into account in determining patentability of claims 7-10, and Examiner's restriction requirement is without basis. This result of course makes eminently good sense, since substantially the same search will be required to determine the patentability of claims 7-10 and 17-23.

Conclusion

Applicant has responded to Examiner's restriction requirement by electing group III with a traversal of the restriction between groups II and II and by further electing species B pending a finding that the generic claim is patentable. Applicant has further demonstrated in his traversal that the restriction between groups II and III is without basis. Applicant has thereby been completely responsive to the restriction requirement and respectfully requests that Examiner examine claims 7-10 and 17-23. No fees are believed to be required by way of this response. Should any be, please charge them to deposit account number 501315.

Respectfully submitted,



Attorney of record,

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October 14, 2004

Date

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on October 14, 2004
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Gordon E. Nelson, #30,093

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